

REMARKS**Status of the Claims**

Upon entry of the amendment above, claims 1-19 and 22-26 will be pending, claims 1, 22, 23, and 24 being independent.

Summary of the Office Action

Claims 8-10, 20, and 21 are rejected 35 USC §112, first paragraph, as *allegedly* "containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention."

In addition, claims 8-10, 20, and 21 are rejected under 35 USC §112, *second* paragraph, on the basis that "[t]he claims are indefinite in that they include limitations drawn to elements beyond that which may be considered subject matter which is regarded as the invention, as recited above in detail" (apparently a reference to the rejection under §112, first paragraph).

Claims 1-7, 11-19, and 22-26 are allowed.

Response to the Office Action**A. Summary of Prosecution To-Date**

Over four years ago, *viz.*, on May 27, 1999, Applicants presented claims in parent application No. 08/759,416 which were copied from U.S. Patent No. 5,797,610.

That patent (US '610), the application of which had been filed on February 13, 1997, appears to Applicants to have been inadvertently issued by the Office (now more than five years ago), inasmuch as Applicants' parent application, as well as Applicants' priority application (filed on December 8, 1995), had been filed prior to the filing date of that patent.

Approximately three years ago, on September 12, 2000, all claims in the above-mentioned parent application were allowed and *ex parte* prosecution was suspended for six months, supposedly for the purpose of setting up an interference.

However, the instant divisional application was filed upon the Examiner having determined that the claims of the parent application, issued in Applicants' U.S. Patent No. 6,196,556, were directed to invention(s) that is/are independent and distinct from that of the copied claims. Therefore, the copied claims were re-filed as claims 1-26 in this divisional application. The instant application also included non-copied claims 27-31.

In an electronic message on December 11, 2000, for the stated purpose of simplifying the Examiner's efforts in preparing the instant application for interference, the Examiner requested that claims 27-31 be canceled rather than having Applicants merely file a terminal disclaimer to overcome an obviousness-type double patenting rejection. The Examiner explained that if Applicants were to agree to cancel claims 27-31 from the instant application, rather than to file a terminal disclaimer (leaving only claims that had been copied from US '610), he would be agreeable to having such claims re-filed and allowed, following the successful outcome of the interference proceeding.

Consistent with the Examiner's message, an Office action issued on January 2, 2001, declaring copied claims 1-26 to be allowed, while claims 27-31 were rejected for obviousness-type double patenting over the claims of Applicants' parent patent (*i.e.*, US '556).

For the purpose of facilitating the Examiner's preparation of an interference, therefore, and at the Examiner's request, Applicants canceled claims 27-31 on April 21, 2001.

Over two years ago, on May 2, 2001, all claims (*i.e.*, copied claims 1-26) were again declared "allowed" and *ex parte* prosecution of the instant application was suspended for six months, again supposedly for the purpose of setting up the interference.

Upon expiration of the suspension period, and in response to the Applicants' status inquiry filed on November 2, 2001, the Examiner issued a communication on December 18, 2001, requiring that a paper be filed applying each limitation of the copied claims to the disclosure of the instant application, despite such a paper having been filed in the parent application.

On January 10, 2002, prior to the end of the time period for response to his communication of December 18, 2001, the Examiner re-issued the requirement made in his December 18th communication and he included objections to the wording used in certain ones of the claims, *i.e.*, he objected to the wording of claims that were copied from US '610.

Following Applicants' response, all claims of the instant application were allowed yet again, more than a year ago, on June 13, 2002.

In addition, *ex parte* prosecution of the instant application was once again suspended for six months, once again supposedly for the purpose of setting up the interference.

Upon expiration of the third six-month suspension period, and in response to yet another status inquiry filed by Applicants on December 13, 2002, the new non-final Office action to which Applicants now reply was issued.

The application has yet to be prepared for interference.

B. Withdrawal of Rejection Under 35 USC §112, Second Paragraph

As mentioned above, claims 8-10, 20, and 21 are rejected 35 USC §112, first paragraph, as *allegedly* "containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention."

In addition, as also mentioned above, claims 8-10, 20, and 21 are rejected under 35 USC §112, *second* paragraph, on the basis that "[t]he claims are indefinite in that they include limitations drawn to elements beyond that which may be considered subject matter which is regarded as the invention, as recited above in detail."

As explained in *In re Moore*, 169 USPQ 236, 238 (CCPA 1971), when rejections of both first and second paragraphs of 35 USC §112 are at issue:

Any analysis in this regard should begin with the determination of whether the claims satisfy the requirements of the second paragraph. It may appear awkward at first to consider the two paragraphs in reverse order but it should be realized that when the first paragraph speaks of "the invention", it can only be referring to that invention which the applicant wishes to have protected by the patent grant, i.e., the *claimed* invention. For this reason the claims must be analyzed first in order to determine exactly what subject matter they encompass. [Emphasis in original.]

The second paragraph of 35 USC §112 includes two requirements: (1) that the claims are clear and precise; and (2) that the claims describe subject matter which the applicant regards as the invention. See, e.g., the *Manual of Patent Examining Procedure* (Rev. 1, Feb. 2003), §§2171, 2173.02.

Consistent with the foregoing, *In re Ehrreich*, 200 USPQ 504, 508 (CCPA 1979), explained the requirements of §112, second paragraph, as follows:

The second paragraph of §112 pertains *only* to the claims. In *re Borkowski*, 57 CCPA 946, 951 422 F.2d 904, 909, 164 USPQ 642, 645 (1970). Agreement or lack thereof, between the claims and the specification is properly considered only with respect to the first paragraph of §112; it is irrelevant to compliance with the second paragraph of that section. [Emphasis in original.]

The rejection under 35 USC §112, second paragraph, at issue now in the instant application, is based upon the reasoning that "[t]he claims are indefinite in that they include recitations drawn to elements beyond that which may be considered subject matter which is regarded as the invention, *as recited above in detail*." (Emphasis added.) And that which is "recited above" in the Office action pertains only to allegations of limitations of claims 8, 20, and 21 for which "[t]here is no such structure in the instant application." (See the middle of page 2 of the Office action.)

Therefore, as in *Ehrreich*, the instant rejection appears to be based upon a lack of agreement between the rejected claims and the specification.

No reasons are given in the rejection under §112, second paragraph, relating to the claims lacking clarity and precision, *i.e.*, the aforementioned first requirement of §112, second paragraph. Therefore, if the rejection is intended to be based upon the first requirement of §112, second paragraph, Applicants submit that the rejection should be withdrawn.

Regarding the aforementioned second requirement of §112, second paragraph, as explained in *In re Conley*, 180 USPQ 454, 456-457 (CCPA 1974), the court stated:

Occasionally ... the second paragraph of §112 has been relied upon as a basis for rejection of a claim, not because of "indefiniteness" of the claim language but because the language used did not particularly point out and distinctly claim the subject matter *which the applicant regards as his invention*. This portion of the statutory language has been relied upon in cases where some material submitted by applicant, *other than his specification*, shows that a claim does not correspond in scope with what *he regards* as his invention. [Emphasis in original; citations omitted.]

The CCPA's holding in *Conley* echoes its earlier holding in *In re Borkowski*, 164 USPQ 642 (CCPA 1970), namely, that there is no basis for rejecting under the aforementioned second requirement of §112, second paragraph (*i.e.*, the "regards as his invention" requirement) unless there is evidence *beyond* an applicant's disclosure which suggests a difference between what is claimed and what the applicant "regards as his invention." See also, MPEP §2172.I.

In the instant rejection under 35 USC §112, second paragraph, no evidence is put forward beyond Applicants' disclosure to suggest a difference between what is claimed and what Applicants regard as their invention. Therefore, if the rejection is intended to be based upon the aforementioned second requirement of §112, second paragraph, the rejection should be withdrawn.

Applicants submit that the instant rejection under 35 USC §112, second paragraph, is quite similar to the one reversed by the court in *Borkowski*, where the court explained, at pages 645-646:

The examiner's approach to determining whether appellant's claims satisfy the requirements of §112 appears to have been to study appellants' disclosure, to formulate a conclusion as to what he (the examiner) regards as the broadest invention supported by the disclosure, and then to determine whether appellants' claims are broader than the examiner's conception of what 'the invention' is. We cannot agree that §112 permits of such an approach to claims. The first [part] of the second paragraph of §112 is essentially a requirement for *precision and definiteness* of claim language. If the scope of subject matter embraced by a claim is clear, and if the applicant has not otherwise indicated that he intends the claim to be of a different scope, then the claim does particularly point out and distinctly claim the subject matter which the applicant regards as his invention. That is to say, if the "enabling disclosure" of a specification is not commensurate in scope with the subject matter encompassed by a claim, that fact does not render the claim imprecise or indefinite or otherwise not in compliance with the *second* paragraph of §112; rather, the claim is based upon an *insufficient disclosure* (§112, first paragraph) [Emphasis in original; citations omitted.]

In summary, Applicants submit that the instant rejection under 35 USC §112, second paragraph, should be withdrawn, consistent with the reversal of the rejection in *Ehrreich*, as explained on page 508:

Since this rejection is not based on indefiniteness or lack of clarity of claim language, but only on the alleged lack of agreement with the scope of the specification, we reverse it as having been improperly made.

C. Withdrawal of Rejection Under 35 USC §112, First Paragraph

As mentioned above, claims 8-10, 20, and 21 are rejected 35 USC §112, first paragraph, as *allegedly* "containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention."

Although five claims are rejected, only limitations appearing in claims 8 and 20 appear to be at issue, based upon comments included in support of the rejection. Claims 9 and 10 are believed to have been included in the rejection because they depend from claim 8, and claim 21 is believed to have been included because it depends from claim 20. Accordingly, Applicants' response will be directed to claims 8 and 20.

1. Claim 8

As explained in Section 2161 of the MPEP, three requirements are made of an Applicant's application disclosure under 35 USC §112, first paragraph: (1) a written description of the invention; (2) enablement of the invention (*i.e.*, "the manner and process of making and using the invention"); and (3) the best mode contemplated by the inventor of carrying out his invention.

The instant rejection includes the statement that "[t]he above claims include recitations drawn to subject matter *not defined or enabled* by the specification." [Emphasis added.]

It appears, then, at least ostensibly, that the claims are rejected on *both* the description and the enablement requirements of §112, first paragraph.

However, Applicants respectfully submit that the reasons in support of the rejection are directed only to the written description requirement. Omitting the Examiner's comments pertaining to claims 20 and 21, which claims are canceled in the amendment above, the following is the entirety of the reasons offered in support of the rejection presently at issue:

The above claims include recitations drawn to subject matter not defined or enabled by the specification. Claim 8 recites "wherein the lower surface of the base defines a projection projecting downwardly from the lower surface, the inlet ventilation aperture being defined within the projection." There is no such structure in the instant application. The inlet ventilation apertures are defined within the base member, and there is no element which can be considered a "projection projecting downwardly", specifically wherein the inlet ventilation aperture as defined by the preceding claim(s) is defined therewithin.

These reasons will be addressed, then, in the context of the written description requirement of §112, first paragraph. See below.

Regarding enablement, however, inasmuch as the above-quoted reasons are insufficient to meet the burden on the Office in making a rejection for non-enablement under §112, first paragraph, Applicants submit, to the extent the rejection is based upon non-enablement, that the rejection should be withdrawn. See, *e.g.*, MPEP §2164.04, entitled "Burden on the Examiner Under the Enablement Requirement." Therein, it is explained that:

A specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.

Further, as explained by the court in *In re Marzocchi*, 169 USPQ 367, 370 (CCPA 1971), and quoted in the aforementioned MPEP section:

it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy

of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement.

No such reasons doubting the truth or accuracy of any disclosure of Applicants has been made and, accordingly, Applicants submit that the rejection fails to meet the burden for making a rejection for non-enablement.

Applicants now turn to the rejection under 35 USC §112, first paragraph, in the context of the written description requirement thereof.

In short, Applicants respectfully submit that the invention of the rejected claims is based upon an original disclosure in compliance with written description requirement.

At the outset, Applicants submit that, to the extent that the term "specification", in the statement in the rejection "[t]he above claims include recitations drawn to subject matter not defined or enabled by the specification" was used as excluding a consideration of Applicants' drawing as providing support for the claimed invention, the rejection is improperly founded. In *In re Berkman*, 209 USPQ 45 45, 46-47 (CCPA 1981), the court observed:

This court has held that drawings may be used to satisfy the disclosure requirement. [Citations omitted.]

See also Vas-Cath, Inc. v. Mahurkar, 19 USPQ2d 1111 (Fed. Cir. 1991).

As stated in MPEP §2163 (Rev. 1, Feb. 2003), to satisfy the written description requirement, a patent disclosure must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. *See, e.g., Vas-Cath, supra*.

In the context of the instant rejection being based upon an alleged failure to comply with the written description requirement of 35 USC §112, first paragraph, Applicants will now

address, with specificity, the reasons presented in support of the rejection and show that Applicants had possession of the invention described in the rejected claims.

The rejection, as mentioned above, is based upon the position that the following limitation from claim 8 (corresponding to claim 9 of US '610) is not adequately disclosed (*i.e.*, is based upon an application disclosure that fails to comply with the written description requirement of 35 USC §112, first paragraph): "the lower surface of the base defines a projection projecting downwardly from the lower surface, the inlet ventilation aperture being defined within the projection."

First, Applicants submit that if they had been responsible initially for having drafted a claim of this type (rather than having copied it from US '610), they would not likely have used the expression "the lower surface" in defining a projection that extends downwardly from "the lower surface." The phrase might, at least at first, appear to be nonsensical from a literal analysis. That is, one might question how a lower surface can extend downwardly from *itself*. Perhaps the rejection springs from such unusual wording.

Regardless, Applicants submit that when the claim is read in light of the disclosure of their application, as well as with an understanding of the origin of the claim in the specification and the drawings of the US '610 patent (see column 4, line 63, to column 5, line 10, and Figs. 4 and 5), the subject matter of Applicants' claim 8 (patent claim 9) can be adequately determined. Further, in so doing, Applicants respectfully submit that the basis for the rejection can be shown to be misplaced and, accordingly, the withdrawal of the rejection is kindly requested.

As an aid in making Applicants' following comments clearly understood, a three-page attachment is appended to this reply. The attachment includes an annotated copy, highlighted in yellow, of Figs. 4 and 5 of the US '610 patent and an annotated copy, also highlighted in

yellow, of Figs. 8a and 9a of Applicants' drawing.

Initially regarding the construction of claim 8, "the lower surface" in the description of the illustrated embodiment of the invention of US '610 refers to reference numeral 28; see column 4, lines 63-65. The end of the lead line in Fig. 2 being broken, as well as the lead line in the bottom view of Fig. 4, shows that "the lower surface 28" refers to the bottom of the shoe. The so-called "projections 44" in US '610 (see Figs. 4, 5), also mentioned in column 4, lines 63-65, refer to a number of integrally molded members in the bottom portion of the shoe, each of which includes a respective inlet aperture 39. In the attachment, the portions of Figs. 4 and 5 that correspond to "projections 44" are highlighted in yellow.

The rejection includes the assertion that "there is no such structure" in Applicants' application. The Examiner further explains that "the inlet ventilation apertures are defined within the base member, and there is no element which can be considered a 'projection projecting downwardly', specifically wherein the inlet ventilation aperture defined by the preceding claim(s) is defined therewithin."

Applicants respectfully disagree.

First, the same characterization made about Applicants' disclosure can in fact be made about that of US '610, *i.e.*, that the inlet ventilation apertures 39 are defined within the base 24.

Further, and contrary to the statements advanced in the Office action, Applicants' application includes embodiments shown in Figs. 8, 8a, and 9, 9a, which include a ventilation chamber integrally molded with the bottom portion of the shoe.

With reference to the embodiment of Applicants' Figs. 9, 9a, *e.g.*, the parts of the "lower surface" (using the wording of US '610) of the base 6D that extend downwardly (see Applicants' Fig. 9a) define (as specified in Applicants' claim 8) "a projection projecting downwardly from the lower surface," with the "inlet ventilation aperture [11D] being defined within the

projection."

To ensure that this is clear, reference is made to the aforementioned attachment whereby the portions of Applicants' Figs. 8a and 9a which can be properly characterized as the "projection" of claim 8 (*i.e.*, the projection of claim 9 of US '610) are highlighted in yellow.

2. Claim 20

Claim 20, which depends from claim 18, which, in turn, depends serially from claims 17 and 1, merely adds that the "substrate" (manifested by "last board" 54 of US '610 - see Fig. 2) further includes an insole within the shoe over the last board. Claim 21, which depends from claim 20, further calls for the insole to have vertically extending apertures.

Applicants have reviewed their specification and accept that explicit reference does not appear to have been made to an "insole." They note, however, that the former Examiner assigned to the instant application appears to have had no difficulty regarding claims 20 and 21, which had declared allowed at least twice (on May 2, 2001 and June 13, 2002), on which occasions all claims were allowed and *ex parte* prosecution had been suspended. An insole, *per se*, of course, is a common feature in footwear.

However, and again for the purpose of advancing the prosecution of the instant application, claims 20 and 21 have been canceled in the amendment above.

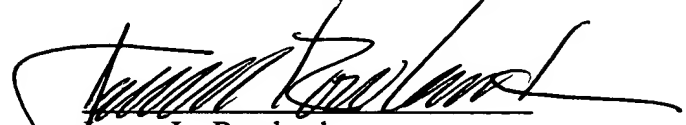
SUMMARY AND CONCLUSION

The grounds of rejection advanced in the Office action have been addressed and are believed to be overcome. Reconsideration and withdrawal of the rejections are therefore requested.

A check is enclosed for payment of a fee for an extension of time. No additional fee is believed to be due at this time. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and complete to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,
Laurent BONAVENTURE et al.

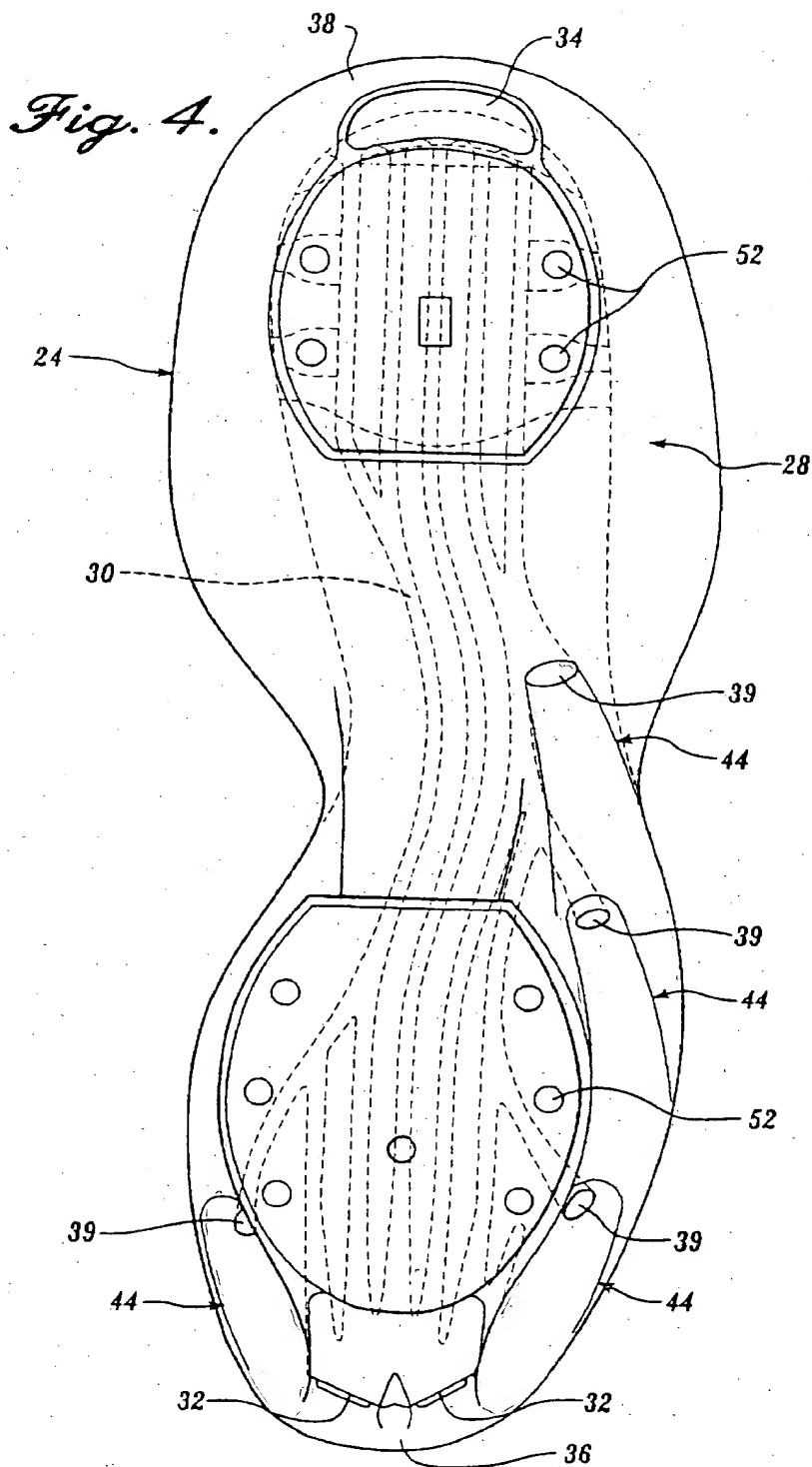


James L. Rowland
Reg. No. 32,674

September 8, 2003
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191

703-716-1191 (telephone)
703-716-1180 (fax)

Attachment



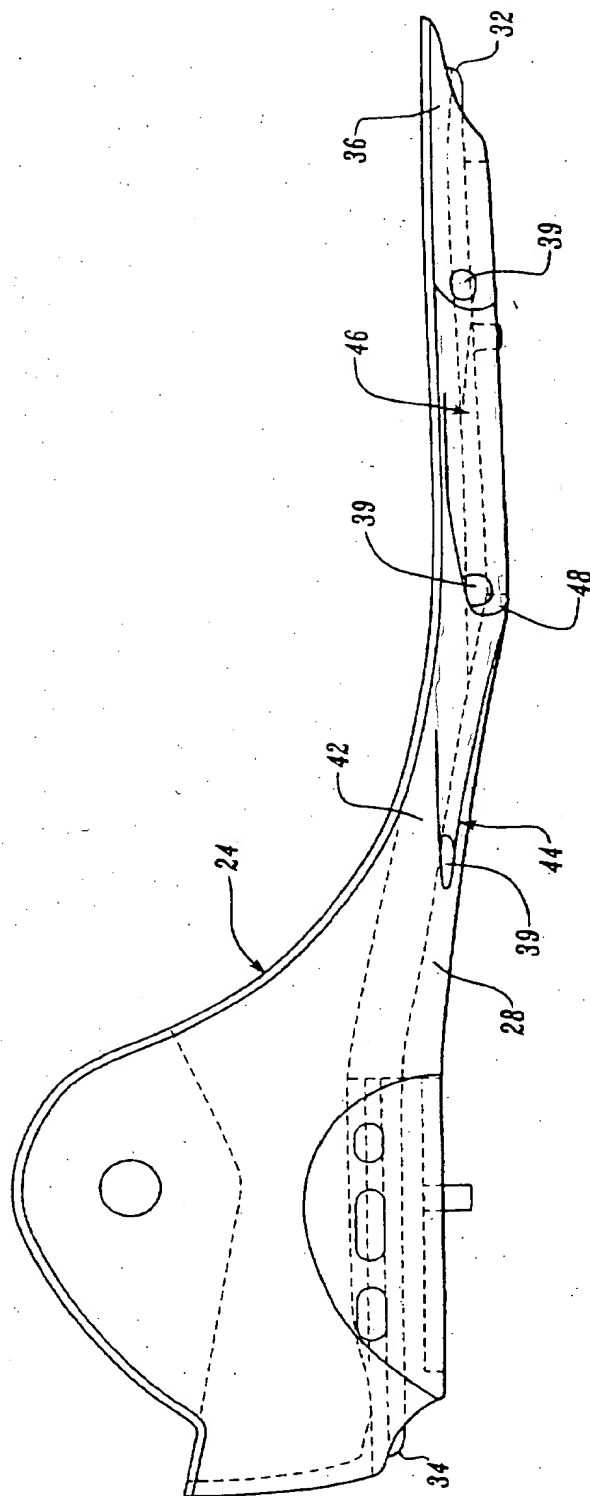


Fig. 5.

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FIG. 6

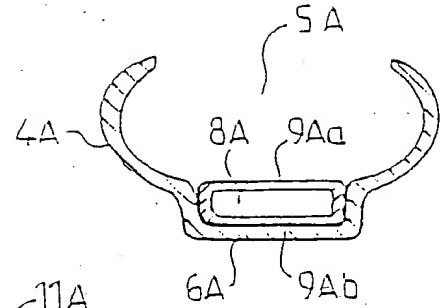
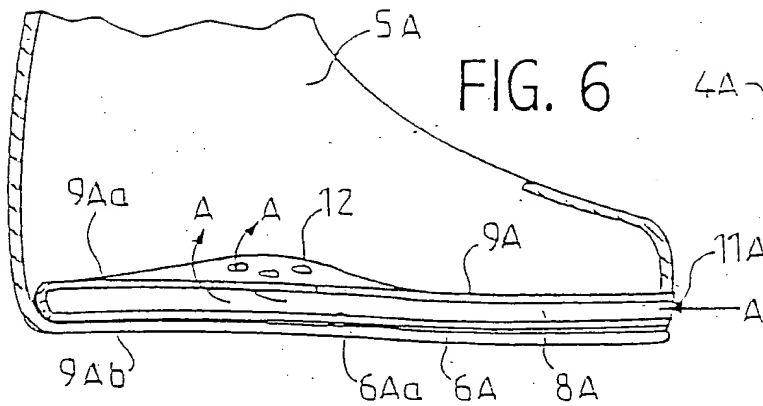


FIG. 6a

FIG. 7

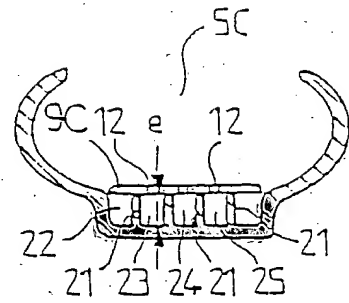
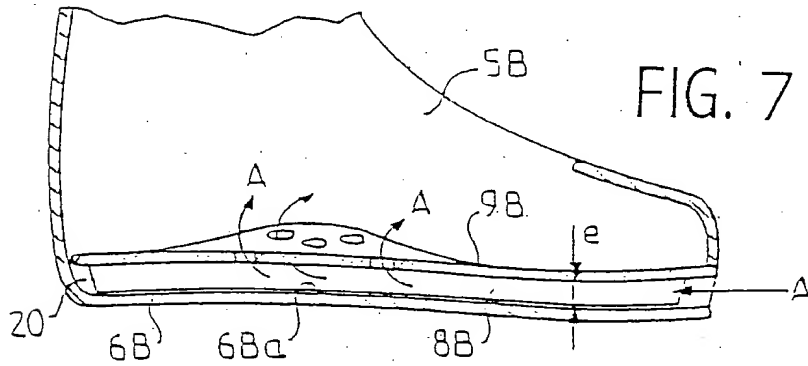


FIG. 8

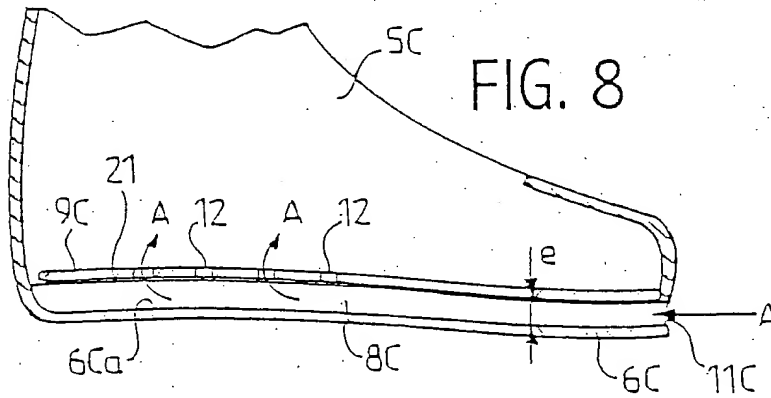


FIG. 8a

FIG. 9

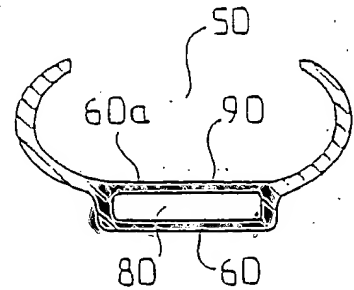
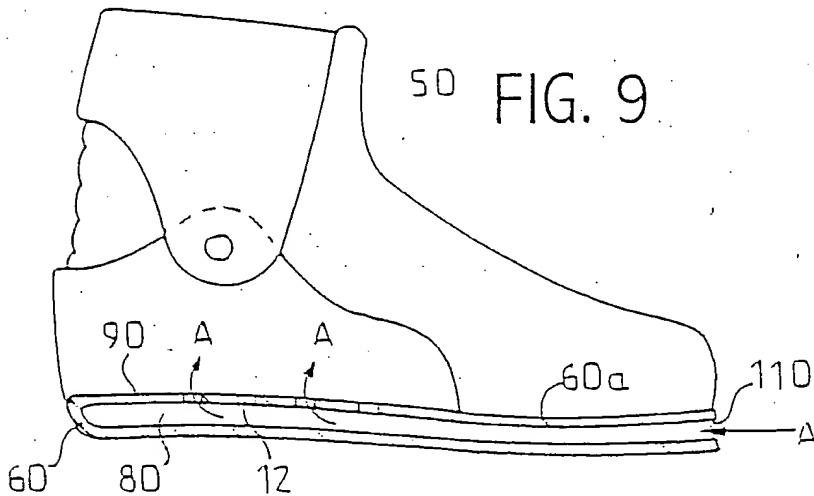


FIG. 9a